

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Office Action dated October 16, 2009 and the Notice of Non-Compliant Amendment dated April 16, 2009. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-9 and 11-21 are currently pending in the Application. Claim 10 is canceled herein, without prejudice. The Applicants respectfully reserve the right to reintroduce subject matter deleted herein, either at a later time during the prosecution of this application or any continuing applications. Claims 1, 6 and 21 are independent claims.

The Applicants note the withdrawal of allowability of claims 1-4, 16, 18 and 21.

In the Office Action, claim 10 is rejected under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the enablement requirement. Without agreeing with the position forwarded in the Office Action, and in the interest of advancing prosecution, claim 10 is canceled herein. It is respectfully submitted that the cancellation of claim 10 renders this rejection of claim 10 moot.

In the Final Office Action, claims 11 and 12 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants respectfully disagree and submit that the specification, such as

page 2, lines 15-25, fully complies with the written description requirements and fully supports the recitation in claim 11 that "upon receipt of the trigger signal, the control unit performs a dedicated wakeup sequence." Specifically, the specification makes clear that "it is advantageous to arrange the control unit to initiate a switching by the monitoring system into a second mode. Therefore, the control unit must have provisions to generate a code that can be added or superimposed to the first signal ... It is possible that upon the system entering the second mode a dedicated wakeup sequence is started which may initiate further communication."

As should be clear, the original disclosure fully supports the claims recitation. Accordingly, withdrawal of the rejections under 35 U.S.C. §112, first paragraph to claims 11 and 12 is respectfully requested.

Claims 12 and 17 are rejected under 35 U.S.C. §112, first paragraph, as allegedly containing features not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time of the application was filed had possession of the claimed invention and also under 35 U.S.C. §112, second paragraph, as allegedly indefinite. These rejections are respectfully traversed.

It is respectfully submitted that the specification provides ample support and sufficient description, as well as fully enables claims 12 and 17, in such a way as to reasonably convey one skilled

in the relevant art that the inventor, at the time of the application was filed had possession of the claimed invention.

For example, page 5, lines 23-26, clearly describes that (emphasis added) "[t]he initiation of the RF-link, schematically represented by a two-directional arrow, is performed only after the trigger signal (T) is received by the biosensors (3) and is decoded by the processing unit of the biosensors (3)."

However, in the interest of furthering consideration and allowance of claims 12 and 17, the subject matter of these claims is amended to address the concerns raised in the Office Action. Specifically, claims 12 and 17 are amended to recite (emphasis added) "the dedicated wake-up sequence includes turning on of an RF-link that is otherwise always in an off-state unless responding to a prior dedicated wake-up sequence." Since the specification makes clear that in one embodiment, initiation of the RF-link is performed only after the trigger signal is received, then the RF-link must necessarily be in an off state, unless it is on in response to a prior wake-up sequence. Clearly, the specification complies with the written description requirement and reasonable conveys that the Applicants, at the time of the application was filed, had possession of the claimed invention. Further, it is respectfully submitted that the claim is definite and clear. Accordingly, withdrawal of this rejection under 35 U.S.C. §112, first paragraph and under 35 U.S.C. §112, second paragraph, is respectfully requested.

Claim 5 is rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite. This rejection of claim 5 is traversed.

As previously pointed out, the term "substantially" is recognized by the Federal Circuit and the United States Patent and Trademark Office as definite because one of ordinary skill in the art would know what was meant by "substantially". However, in the interest of expediting consideration and allowance of the present application, Applicants have elected to amend the claims to remove the term. Therefore it is respectfully submitted that claim 5 satisfies 35 U.S.C. §112, second paragraph. Accordingly, it is respectfully requested that the 35 U.S.C. §112, second paragraph rejection of claim 5 be withdrawn.

Claims 1-2, 4-8, 10, 11, 13, 1, 18 and 21 are rejected under 35 U.S.C. §102(b) over U.S. Patent No. 4,987,897 to Funke ("Funke"). Claims 1-9, 11-12, 16-17 and 21 are rejected under 35 U.S.C. §102(e) over U.S. Patent No. 6,315,719 to Rode ("Rode"). Claims 14-15 and 19-20 are rejected under 35 U.S.C. §103(a) over Funke. These rejections are respectfully traversed. It is respectfully submitted that claims 1-9 and 11-21 are allowable over Funke and Rode for at least the following reasons.

The Office Action has interpreted the claims recitations of configured to ... as being merely functional and has in this way, introduced prior art that does not disclose or suggest the claim recitations. This is very notable in regard to each of the

references and particularly Rode, which was dropped as a reference previously since it was clear, that Rode did not disclose or suggest the claim recitations.

The Applicants note the drastic turnaround of understanding in the terms adapted to ... and configured to ... It is not clear why at this late date in prosecution this turnaround is introduced. While the Office Action properly notes that these terms (emphasis added) "may be interpreted as intended use", the Office Action thereafter makes no attempt to discern whether the recitations in the claims are intended use recitations or not, and thereafter treats each such recitation as an intended use.

The MPEP in §2111.04 makes clear in reference to such recitations that (emphasis added) "[c]laim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are: (A) "adapted to" or "adapted for" clauses; (B) "wherein" clauses; and (C) "whereby" clauses." The MPEP however points out that "[t]he determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "'whereby' clause states a

condition that is material to patentability, it cannot be ignored in order to change the substance of the invention."

The federal courts in "In re Noll" made clear that a computer that is uniquely configured to perform specified functions through the physical properties of electronic circuits to achieve controlled results is structurally different from a machine without that program. See, In re Noll 545 F.2d 141, 191 USPQ 721, 726 (C.C.P.A. 1976). The Applicants have identified over fifty-one thousand issued patents that utilize the terms processor or computer together with limitations drawn to being configured to perform operations. The MPEP requires that some analysis as to whether a recitation is a statement of intended use or a structural/operational limitation, however, the Office Action seems devoid of any such analysis.

Nonetheless, the Applicants have elected at this time to amend the claims to remove these recitations.

It is respectfully submitted that the system of claim 1 is not anticipated or made obvious by the teachings of Funke and Rode. For example, Funke and Rode do not disclose or suggest, a system that amongst other patentable elements, comprises (illustrative emphasis added) "a sensor picking up a first signal in a first mode of the system, the first signal being representative of the physiological condition and forwarding the first signal to a signal processing unit, a control unit positioned remote from the signal processing unit and selectively actuated to effect a system mode

change, the control unit generating a second signal and transmitting the second signal to the sensor superimposed on the first signal, the signal processing unit decoding the second signal and making the system enter into a second mode upon receipt of the second signal, wherein the second signal is received by the sensor as a disturbance of the first signal" as recited in claim 1, and as similarly recited in each of claims 6, and 21.

Based on the foregoing, the Applicants respectfully submit that independent claims 1, 6 and 21 are patentable over S Funke and Rode and notice to this effect is earnestly solicited. Claims 2-5, 7-9, 11-20 respectively depend from one of claims 1 and 6 and accordingly are allowable for at least this reason as well as for the separately patentable elements contained in each of the claims. Accordingly, separate consideration of each of the dependent claims is respectfully requested.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

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